

REMARKS

Claims 1-11, 15-21 and 30-32 are pending and are the subject of the present office action.

Pursuant to the Examiner's request, the title of the invention has been amended, as shown herein.

The amendment is illustrated on the attached page entitled "Marked Up Version to Show Changes Made". For the Examiner's convenience, a clean copy of the now pending claims 1-11, 15-21 and 30-32 is provided above.

Section 102 Rejections

Claims 1-11, 15-21 and 30-32 were rejected under Section 102(e) as being anticipated by Wei et al., US Patent 6,261,801 ("the '801 patent"). Applicants respectfully traverse the rejection.

Applicants first wish to address certain aspects of the disclosure in the '801 patent. The '801 patent claims priority to provisional application no. 60/054,885 filed August 7, 1997 and to provisional application no. 60/035,496 filed January 14, 1997¹. As the Examiner can readily appreciate upon a review and comparison of the '801 patent and its priority applications, the disclosure provided by Wei et al. changed markedly every time their application was re-filed.

As the present application has a priority filing date of June 18, 1997, before the August 7, 1997 filing date of Wei et al.'s 60/054,885 application, the only disclosure which may be considered for purposes of Section 102(e) is that which appears in the January 14, 1997 60/035,496 application filed by Wei et al.

Wei et al.'s 60/035,496 application fails to provide an enabling disclosure for the claims presented in the instant application. While the 60/035,496 application provides certain sequence information for the molecule referred to as TNFR-5, there is no teaching or suggestion in that application as to what TNFR-5 is or what function(s) or activity(s)

¹Both of Wei et al.'s provisional applications have previously been cited in Applicants' Information Disclosure Statement filed for the present application.

that TNFR-5 has. The 60/035,496 application is silent with regard to any characterization of the TNFR-5 molecule. The fact that Wei et al. did not recognize a function or activity of TNFR-5 is demonstrated by the text on page 51, lines 5-18, of the 60/035,496 application wherein Wei et al. suggest the molecule could be employed in connection with diseases as diverse as cancer, autoimmune disorders, AIDS, stroke and toxin-induced liver disease, etc.

Moreover, Wei et al.'s attempt to impute a function or activity to the TNFR-5 molecule in the 60/035,496 application must fail on the basis of their very own admissions made in the application at pages 4, lines 1-3 and 50, lines 21-24, respectively:

The effects of TNF family ligands and TNF family receptors are varied and influence numerous functions, both normal and abnormal, in the biological processes of the mammalian system.

The Tumor Necrosis Factor (TNF) family ligands are known to be among the most pleiotropic cytokines, inducing a large number of cellular responses, including cytotoxicity, anti-viral activity, immunoregulatory activities, and the transcriptional regulation of several genes...

Such statements clearly teach one skilled in the art that uncertainty and unexpectedness surrounds such molecules until the molecules are actually experimentally characterized.

For at least these reasons, the 60/035,496 application fails to provide an enabling disclosure for either TNFR-5 polypeptides or fusion proteins thereof and cannot be applied for purposes of anticipation under Section 102(e) against the claims presented in the instant application.

Applicants note that in the office action, the Examiner has cited Col. 1, lines 10-16, of the '801 patent as providing a teaching that the TNFR-5 or TRID molecule binds to TRAIL (or Apo-2 ligand). It is respectfully pointed out to the Examiner that the teaching by Wei et al. that the molecule binds TRAIL (or Apo-2 ligand) was added to the disclosure in the August 7, 1997 60/054,885 application, AFTER the priority filing date of the instant application. Wei et al. do not teach or suggest any such binding property in their January 14, 1997 60/035,496 application. Accordingly, such disclosure may not be relied upon in the

instant rejection.

Withdrawal of the Section 102(e) rejection and allowance of the claims pending in the present application are respectfully requested.

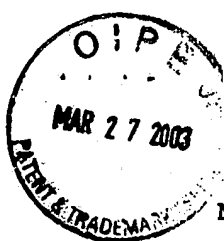
Respectfully submitted,

GENENTECH, INC.

By: *Diane L. Marschang*
Diane L. Marschang
Reg. No. 35,600

Date: March 27, 2003

1 DNA Way
So. San Francisco, CA 94080-4990
Phone: (650) 225-5416
Fax: (650) 952-9881



MARKED UP VERSION TO SHOW CHANGES MADE

In the title of the invention:

Please amend the title on page 1 as follows:

--- Apo-2DcR Polypeptides ---

RECEIVED

APR 03 2003

TECH CENTER 1600/2900